

**Remarks/Arguments**

Claims 1-59 are pending in the application. Claims 1-59 are rejected. Claim 49 is amended. Claim 49 has been amended to correct an obvious typographical error.

**Claim Rejections Under 35 USC § 112**

Claims 21-22 and 27-48 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to all these, it appears that the Examiner may be confused by the language "in a system... a method comprising". The prepositional phrase "in a system" identifies the environment in which the claimed method is carried out. It is proper and well-accepted patent claiming for a claim preamble to set forth the environment for the claimed subject matter. See MPEP § 2111.02 (citing *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 CCPA 1962). Accordingly, the rejection of these claims should be withdrawn. Also, as to claim 22, the method includes the step of "sending a key list". The claim further defines what the list is and to where it is sent. A single step method is patentable subject matter. *Ex Parte Troy G. Porter, Jr.*, 1992 WL 392605, 4 (B.P.A.I. No. 92-1668), citing *In re Kuehl*, 475 F.2d 658, 177 U.S.P.Q. 250 (C.C.P.A. 1973) and *Ex Parte Blattner*, 2 U.S.P.Q.2d 2047 (B.P.A.I. 1987); see also Robert C. Faber, *Landis on Mechanics of Patent Claim Drafting*, 4<sup>th</sup> ed., § 37 (PLI Press, New York City, 2000) ("There is no per se objection to claiming a single-step method, except where a broad functional step is claimed ..."). Claims 45-48 recite the step of "transmitting" and are patentable for this reason too.

Claims 2-19 are rejected as lacking sufficient antecedent basis for "the method". Each of these claims has claim 1 as a base claim. Claim 1 recites "a method comprising...." (p. 40, line 5). Accordingly, this basis for rejection should be withdrawn.

***Claim Rejections Under 35 USC § 102***

Claims 1-59 stand rejected under 35 USC 102(b) as being anticipated by [www.amazon.com](http://www.amazon.com); archived any linkage; October 13, 1999, hereinafter referred to as "Amazon."

A prima facie case of anticipation is not made unless the prior art discloses each element of the claimed invention. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Conhell v. Sears Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). See also MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Full patentable weight must be given to each word in the claim, including the preamble. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Language appearing in the preamble must be included when determining the limitations of the claim. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

All rejections are clearly erroneous because the Office Action has not identified how the cited prior art discloses, teaches, or suggests various claim elements or limitations recited in the claims or in the specific arrangement recited in the claims. In addition, when all elements and limitations are properly considered, Applicant respectfully submits that all claims are clearly patentable over Amazon, as further described below.

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#### **Overview of Certain Salient Inventive Features**

Applicant takes this opportunity to summarize certain salient aspects of the present invention as a convenient aid for the Examiner to appreciate how the claims distinguish over the cited art. In typical prior art systems, a web user, via a "client computer system" receives documents directly from a content provider's consumer system. In the context of the present invention, the web pages provided through the website [www.amazon.com](http://www.amazon.com) would generally each be considered an "electronic content document" maintained by a content provider, namely Amazon.com. In this typical scheme, Amazon.com controls what hyperlinks to additional content are included on its web pages. The user is constrained to those links provided by Amazon.com and cannot conveniently access (hyperlinked) information about any other "key element" on the web page, i.e., topic of interest, represented by, for example, the name of a movie — unless the user leaves the web page or opens a new browser window, for example, or enters the key element into a search engine interface.

The present invention realizes that the electronic content documents may include many key elements of interest to users that are not associated with hyperlinks provided by the content provider. Therefore, users do not have convenient access to relevant information about a key element the provider elected not to link. Further, even if there is a preexisting hyperlink, it may link to information not of interest to the user. To overcome the shortcomings in the conventional system, the present invention discloses and claims the use of a "central computer system"

(CCS) that allows for enhancement of the electronic documents stored on a content provider's computer system so that users, through their client computer system, have wider and more convenient access to information of possible interest. The CCS enhances the electronic documents via recognition and/or annotating functions that are disclosed and claimed. Turning now to the claims, it will be apparent that the cited prior art does not have the aforementioned features and functions.

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**Amazon Does Not Disclose the Claimed Elements or Limitations**

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As to claims 1,20, 22, 27, 33, 45, 48-49, and 53-54, the Office Action merely asserts that Amazon "teaches a website and method for searching key words and that the system identifies and returns results related to items to the client. (Amazon, p. 12.)"<sup>1</sup> The cited Amazon page appears to show merely an electronic content document from a content provider's computer system, standard hyperlinks, and search engine interfaces.

As to claim 1, the Office Action does not identify anything, nor does the page show anything that corresponds to the claimed (1) "embedding code executable by a client computer to invoke the central computer system to recognize key elements on a document corresponding to the content document"; (2) "recognizing key elements in the document", or (3) "generating annotation instructions for the client computer system to create one or more annotations for one or more key elements in the content document and sending the instructions to the client computer system." The Office Action does not address how anything in Amazon corresponds to the specific terminology of the claims or the arrangement of the features. In fact, there is nothing in Amazon that does correspond to the specific features or arguments. Accordingly, a *prima facie* rejection has not been made, and the rejection must be withdrawn.

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<sup>1</sup> Applicant understands that this and other page reference is to the handwritten page numbers on the print-out of web pages comprising the Amazon reference:

Claim 20 also recites similar features for recognizing key elements and annotating key elements and is therefore patentable for the same or analogous reasons as the above claim. Further claim 20 recites that a web page presented through a second computer system (e.g., the web page presented to an Amazon.com user) is sent to a first computer system (e.g., the central computer system) for recognizing key elements and returning annotation instructions to the second computer system for that web page. Nothing even remotely close to this is disclosed in the Amazon reference.

Claim 22 recites similar features for recognizing key elements and annotating key elements and is therefore patentable for the same or analogous reasons. Further claim 22 recites sending a key list of key elements and corresponding identifiers. The Office Action does not identify, nor does Amazon disclose even remotely, anything that corresponds to the claimed (1) sending of a key list, (2) the use of key elements and corresponding identifiers in the key list, or (3) the use of the key list on the client computer system to recognize or annotate key elements on an electronic document from a content provider's computer system.

Claim 27 recites features similar to claim 20 and is patentable for at least the same or analogous reasons.

Claims 33 and 45 recite features similar to claims 1 and 22 and are patentable for at least the same or analogous reasons. In addition, these claims have other limitations that further distinguish over Amazon, including the nature of data transmission following user selection (claim 33) and the functional interplay between a central computer system and consumer computer system and use of a URL (claim 45).

Claims 48 and 49 recite similar features to claim 22 and are patentable for at least the same or analogous reasons. Further, the claims recite code stored and executable on a specific computer and used in a specific functional interplay between a central computer or second system and a client or consumer computer system relative to an electronic page

received by the client computer system from a content provider computer system. The Office Action does not identify anything in Amazon, nor is there anything in Amazon, that even remotely corresponds to the claimed code for this specific interplay.

Claim 53 is a system claim with similar elements and limitations as expressed in claims 1 and 22 and is patentable for at least the same or analogous reasons. Further, the Office Action does not identify anything in Amazon, nor is there anything in Amazon, that even remotely corresponds to the specific recitation of a first computer system with a stored key list for use relative to an electronic content page from a content provider computer system.

Claim 54 is directed to a Web document with code for performing certain functions similar to those expressed in claim 1 and other claims discussed above and is patentable for at least the same or analogous reasons. Further the Office Action does not identify anything in Amazon, nor is there anything in Amazon, that even remotely corresponds to the specific recitation of how the code in the Web document initiates an annotation process through a remote computer resulting in the creation of an annotation for a key element in that document.

In view of the foregoing, the rejections of all the aforementioned claims are traversed. Because the aforementioned claims represent all independent claims in the application, it is axiomatic that the rejections of all dependent claims in the application are also traversed. Nonetheless, certain specific dependent claim rejections will also be addressed and are patentable for at least the following reasons, independent of the fact that they have a patentable independent claim as a base claim.

As to claims 2-4, 15-17, 23, 25, 32, 44, and 50, the Office Action asserts that Amazon teaches embedding code in the document (p. 26). However, the cited page shows merely standard HTML coding preexisting in the electronic content page from the content provider. It does not disclose (1) the claimed functional interplay of recognition and annotation based on the use of an independent central computer system and/or (2) a key list with key elements and

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associated identifiers in functional interplay with a client or consumer computer system. Further, the Office Action asserts an inherency argument for elements admittedly not taught by Amazon. Inherency is not established by speculation—the asserted inherent element must necessarily be present in the prior art. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). In addition to the foregoing distinctions, the claims recite other features that go beyond Office Action's asserted embedding and control of code.

Claims 2-4 and 32 express the fact that code may be embedded by different parties other than the content provider (Amazon) and that therefore there are programming choices that do not lead necessarily to the conclusion that code is inherently embedded by any particular system. Therefore, the inherency rejection is traversed. Claims 57-58 have similar elements or limitations and are patentable for the same or analogous reasons. Further, the fact that "trusted partners" may provide content does not disclose that the partners' computer systems perform any of the server functionality recited in claim 54, the base claim for claims 57-58.

Claim 15, which depends from claim 13, includes the limitation of dynamic generation of a data object and that the data object is executable by the client computer system. The rejection of this claim is traversed because the Office Action does not identify anything in Amazon, nor is there anything in Amazon, that even remotely corresponds to these features. Claim 44 recites similar features and is patentable for the same or analogous reasons.

Claims 16 and 17 recite, respectively, that the (1) recognizing and (2) generation of annotation instructions occur on the central computer system as opposed to, e.g., Amazon's computer system. The rejections of these claims are traversed because the Office Action does not identify anything in Amazon, nor is there anything in Amazon, that even remotely corresponds to these features.

As to claims 5-6, 28-29, 34, 36, 42, 46-47, 51-52, and 55, the Office Action asserts that Amazon "teaches product categories used to browse". It appears that there is some error in the

assessment of this group of claims because none recites use of browsing by product categories. In fact, no claim in the group even uses the term "product" except claim 36, but which does not use the term "browse" or "categories". The claim recites the use of "key element data to formulate a query" and the functional interplay of computer systems. These features are neither identified in the Office Action nor present in Amazon. Claim 43 depends from claim 42 and is patentable for at least the same reasons. Claims 56-58 depend from claim 54 and are patentable for at least the same reasons.

As to claims 7-8, 13, 26, 35, and 37, the Office Action asserts merely, "Amazon teaches information about products found in query" (Amazon, p.14). Here also there appears to be some error, in that claims 13 and 26 do not reference "products." Further, these claims recite features that are not identified in the Office Action nor present in Amazon. As to claims 7-8, 35, and 37, while these claims do mention "products," the claimed context is different from Amazon in view of the other features recited in the claims, which are neither identified in the Office Action nor present in Amazon. Claims 9 and 38 are patentable for the same or analogous reasons. Claim 14 depends from claim 13 and is patentable at least for the same reason.

As to claims 12, 41, and 59, the Office Action asserts that "Amazon teaches categories with links to those products" (p. 20). However, this group of claims does not use this terminology, and Amazon does not teach or suggest the features that are recited.

As to claim 18, the Office Action asserts that Amazon "teaches hyperlink associated with key elements." However, the claim recites "the annotation instructions direct the creation of a hyperlink in association with a key element." Therefore, the Office Action has not identified every claim element or limitation, and the rejection must be withdrawn. Further, nothing in Amazon even remotely teaches the use of annotation instructions, as disclosed and claimed.

As to claims 19 and 24, the Office Action asserts that Amazon teaches "instant information related to key elements" (p. 4). However, claims 19 and 24 do not use the words

"instant information related to key elements." Claim 19 recites "the annotation instructions direct the creation of a pop-up window with links to information related to a key element recognized by the recognizer." Claim 24 recites "the code includes means for key elements to be associated with a pop-up window displaying at least one link to information related to a key element on the electronic document." These specifically recited features are neither identified in the Office Action nor are they present in the cited section of Amazon.

As to claims 21 and 31, the Office Action asserts that "Amazon teaches transmitting information based on user selection." However, the claims recite other elements or limitations concerning the use of corresponding identifiers and key element data (claim 21) and functional interplay of computer systems involving recognizing key elements and sending annotation instructions (claim 31). The cited passage in Amazon does not disclose any of these features and merely says that Amazon can send recommendations to users based on past purchases, for example. The cited passage does not disclose anything about how this is technically done.

In view of the foregoing reasons, all claims stand clearly, patentably distinct over the cited art, and Applicant has not raised other possible grounds for traversing the rejections.

Therefore, nothing herein should be deemed as acquiescence in any rejection or waiver of arguments not expressed herein.

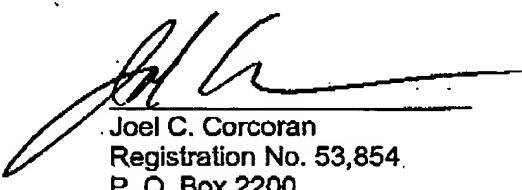
**CONCLUSION**

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees, including extension fees, which may be required, or credit any overpayments, to Deposit Account No. 50-1001.

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Respectfully submitted,

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